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EXAMINER
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MA, JOHNNY

ART UNIT	PAPER NUMBER
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2623

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/497,071	<b>Applicant(s)</b> HOFFBERG-BORGHESE ET AL.	
	<b>Examiner</b> Johnny Ma	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 155-193 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 155-193 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 155-193 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 187 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 187, the specification does not provide a written description regarding the application of hypertext to a displayed list of available media. The Hoffberg '454 patent and Applicant's specification only discloses "[t]he help system may incorporate a hypertext-type system, wherein text or information relating to concepts that are conceptually linked may be easily accessed from one another, and in a logical sequence. To eliminate the possibility of the user trying to make selections on merely informative help screens, the cursor, in these cases, should be locked to a choice which returns the user to where they left off in the programming sequence, and this choice should be highlighted" (Hoffberg '451, 35:1-24; Specification pg. 127). However, the manner in which hypertext is incorporated into a list of available media is

Art Unit: 2623

not described nor it is clear as to how such hypertext functionality would apply to the list of available media.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 156 and 186 are rejected under 35 U.S.C. 102(b) as being anticipated by Strubbe (US 5,223,924 of record).

As to claim 156, note the Strubbe reference that discloses a system and method for automatically correlating user preferences with a T.V. program information database. The claimed “storing data describing available media” is met by “[i]n the embodiment herein, the TV program information data records downloaded as PID as described, for example, in the references incorporated herein” (Strubbe 4:17-21). The claimed “and storing data representing characteristics of media previously selected by a user, wherein said data representing characteristics are not input by the user” is met by “[m]emory section 54 is used to store as a second database, records selected from the first database which are indicated as ‘liked’ by the user...or ‘disliked’ by the user” (Strubbe 4:21-56) wherein “liked” can be indicated at the “option of the viewer, merely watching and/or recording a television program for longer than a given amount of time” (Strubbe 5:23-32) and the second database contains a text summary of each record stored (Strubbe 5:48-51). The claimed “performing a search of said available media for a correspondence to specific data representing said characteristics of programs media

Art Unit: 2623

previously selected by said user” is met by “[e]ach stem in each ‘liked’ record is given a positive weight. Each stem in each ‘disliked’ show, which is not simultaneously a stem in a ‘liked’ show is given a negative weight. With these stems and weights a ‘simple query’ is performed over the records provided from the first database, i.e. the downloaded TV program database” (Strubbe 5:54-6:4). The claimed “notifying said user of available media having characteristics similar to characteristics of a previously selected media” is met by “[t]his third database, could be accessed by the viewer via remote control 42, in order to allow him to select for viewing, only preferred programs which correspond either to forthcoming programs stored in the second database and indicated as ‘liked’, or programs automatically selected from the first database in the interest matcher mode described in FIG. 5” (Strubbe 5:36-42). The claimed “wherein said media comprises a media program; wherein said media comprises television programs” is met by “a television transmission system which provides, along with television programming, updatable TV program information which can, for example, include text summaries of the television programs scheduled for the coming week” (Strubbe 1:57-61). The claimed “and said data describing available media comprises a channel guide list” is met by “[b]y accessing this database, the user can display ‘Future Programs’ as well as ‘Favorite Broadcast Programs’ using a system of advanced menus and displays and an expanded channel ring” (Strubbe 2:42-49) and “[i]n a preferred embodiment, the processor utilizes ‘free text’ search techniques to correlate the TV program information with the viewer’s preferences” (Strubbe 1:67-2:2) wherein program “information can comprise title, channel, category, day, time, length, repeat rate etc., as well as summaries [context], ratings, recommendations and cost for each of the programs featured” (Strubbe 2:9-12).

Art Unit: 2623

As to claim 186, please see rejection of claim 156.

6. Claims 182 and 183 are rejected under 35 U.S.C. 102(b) as being anticipated by Robertson (“New CD-ROM format brings real-time video” of record).

As to claim 182, note the Robertson Article that discloses a system for recommending books to users based favorite authors. The claimed “storing data representing content-dependent characteristics of media previously selected by a respective user” is met by “[t]he customer touches the names of favorite authors, and the program, a sort of ‘smart clerk, searches for authors that the customer might also like” (paragraph 12) wherein it is inherent that the selected names of favorite authors (content-dependent characteristics of media previously selected by a respective user) be stored, at least temporarily, in order for the system to perform a search for recommendations. The favorite authors are content-dependent characteristics in that the authors are contained within a searchable digital field which is dependent on the book/content to which it relates. Furthermore, authors represent characteristics of media previously selected by a respective user because it is inherent that the selection of an author as a favorite represent opinions formed from books written by that author previously selected/read by the user. The claimed “determining a set of available media, the set being associated with data representing content-dependent characteristics of members of the set of available media” is met by the store’s inventory for recommending books and searching for authors that the customer might like (paragraph 12). The claimed “determining a correspondence between content-dependent characteristics of available media and content-dependent characteristics of media previously selected by the user” is met by “[t]he customer touches the names of favorite authors, and the program, a sort of ‘smart clerk, searches for authors that the customer might also like” and

Art Unit: 2623

recommending books to the passerby (paragraph 12). The claimed “outputting, for the user, an identification of at least one member of the set of available media having content-dependent characteristics corresponding to content-dependent characteristics of previously selected by that user” is met by the recommendation of books to the passerby wherein it is inherent that the identification of at least one member of the search results be outputted to the user in order for the system to notify and thus recommend books to the user.

As to claim 183, note the Robertson Article that discloses a system for recommending books to users based favorite authors.

The claimed “receiving data describing a plurality of characteristics of available media” is met by the disclosed “Apont-of-purchase system for bookstores uses MS-DOS, a touchscreen, and CD-ROM technology to sort through a store’s inventory and recommend books to the passerby” (paragraph 12) wherein it is inherent that the characteristics (author names) be received by the system, into the store’s inventory, in order for the search to be performed.

The claimed “defining data representing a plurality of characteristics of media previously selected by a user” is met by the entry of favorite authors (a plurality of characteristics) by touching the name, wherein favorite authors is a preexisting condition/characteristics which is not input by the user (paragraph 12).

The claimed “determining a relation between the available media and the media previously selected by the user, based on a respective plurality of characteristics of the available media and media previously selected by the user” is met by “the program, a sort of ‘smart clerk,’ searches for authors that the customer might also like” in accordance with the store’s inventory (available media) (paragraph 12) wherein the search represents said characteristics of media previously

Art Unit: 2623

selected by said user in that a person forms opinions as to favorite authors from opinions of books (media) by various authors that had been previously selected wherein the available media include associated parameters as discussed above.

The claimed “producing an output in dependence on the determined relation” is met by the recommendation of books to the passerby wherein it is inherent that the identification of at least one member of the search results be outputted to the user in order for the system to notify and thus recommend books to the user.

As to claim 184, please see rejection of claim 183 wherein the store’s inventory comprises a plurality of books (Robertson, paragraph 12).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 155, 162, 174-177, and 179 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (“New CD-ROM format brings real-time video” of record) in further view of the Washington Post article titled “The Audio Book Business” (“WP Article”).

As to claim 155, note the Robertson Article that discloses a system for recommending books to users based on favorite authors. The claimed “storing data describing available media” is met by the store inventory (available media) for sorting and recommending books to the passerby wherein it is inherent that the store inventory data be stored for the sorting process (paragraph

Art Unit: 2623

12). The claimed “and storing data representing characteristics of media previously selected by a user” is met by “[t]he customer touches the names of favorite authors (characteristics)...” for the system to use in performing a search (paragraph 12), note that it is inherent that the favorite authors (characteristics) be stored at least temporarily in order for the search to be performed. The claimed “wherein said data representing characteristics are not input by the user” is met by the entry of favorite authors by touching the name, as discussed above, wherein favorite authors are preexisting conditions/characteristics which are not input by the user (paragraph 12). The claimed “performing a search of said available media for a correspondence to data representing said characteristics of media previously selected by said user” is met by “the program, a sort of ‘smart clerk,’ searches for authors that the customer might also like” in accordance with the store’s inventory (available media) (paragraph 12) wherein the search represents said characteristics of media previously selected by said user in that a person forms opinions as to favorite authors from opinions of books (media) by various authors that had been previously selected. The claimed “notifying said user of available media having characteristics corresponding to characteristics of previously selected media” is met by the point-of-purchase system for sorting through a store’s inventory and recommend books to the passerby wherein it is inherent that the system notify the customer of the results of the sorting (paragraph 12) in order for the system to recommend books to the customer. Note the Robertson Article teaches media comprising books sold in bookstores. However, the Robertson Article is silent as to “wherein said media comprises a media program.” Now note the WP Article that discloses the sale of audio books in book stores (WP Article, see paragraphs 3 and 19). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time

Art Unit: 2623

the invention was made to modify the Robertson book recommendation system to include the recommendation of audio books (media programs), as taught by the WP Article, for the purpose increasing product sales by making the content of books available to people who otherwise would not have time to read any of the book and to provide a product that “is a marvelous way to supplement [people’s] reading” (WP Article, see paragraph 3).

As to claim 162, note the Robertson Article that discloses a system for recommending books to users based favorite authors. The claimed “a controller for controlling delivery of a media [...] to a user” is met by “A point-of-purchase system for bookstores uses MS-DOS, a touchscreen, and CD-ROM technology to sort through a store’s inventory and recommend books to the passerby” (paragraph 12) wherein the point-of-purchase system (controller) controls the delivery of books (media) to a user through recommendations. The claimed “a processor for determining a correspondence between data representing characteristics of media [...] within a set of available media with data representing characteristics of media previously presented to the user” is met by the point-of-purchase system for which “[t]he customer touches the names of favorite authors, and the program, a sort of ‘smart clerk,’ searches for authors that the customer might also like” (paragraph 12) wherein a processor is inherent to the system for performing a search for authors that the customer might also like and the correspondence relates to data representing characteristics of media previously presented to the user in that it is inherent that the books (media), at least by favorite authors, be previously presented to the user in order for the user to form an opinion as to favorite authors (characteristics). The claimed “wherein said data representing characteristics are not input by the user” is met by the entry of favorite authors by touching the name, as discussed above, wherein favorite authors are preexisting

Art Unit: 2623

conditions/characteristics which are not input by the user (paragraph 12). The claimed “and producing a signal dependent on said correspondence” is met by the point-of-purchase system for recommending authors to a customer wherein it is inherent that a signal dependent on the correspondence be produced in order to notify the user of recommendations. Note the Robertson Article teaches media comprising books sold in bookstores. However, the Robertson Article is silent as to wherein said media comprises a media program. Now note the WP Article that discloses the sale of audio books in book stores (WP Article, see paragraphs 3 and 19). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson book recommendation system to include the recommendation of audio books (media programs), as taught by the WP Article, for the purpose increasing product sales by making the content of books available to people who otherwise would not have time to read any of the book and to provide a product that “is a marvelous way to supplement [people’s] reading” (WP Article, see paragraph 3).

As to claim 167, the claimed “wherein a presentation of media is restricted in dependence on a financial transaction.” Note the Robertson Article teaches selling books at a book store as discussed in the rejection of claim 162. However, the Robertson Article is silent regarding “wherein a presentation of media is restricted in dependence on a financial transaction.” Nevertheless, the examiner takes Official Notice that it is notoriously well known in the art of product sales to restrict access to the products until purchased, such as sealing magazines, videos, or books which cannot be opened until the consumer has purchased the product for the purpose of ensuring that the authors of the works/products and seller receive compensation for the consumption of the products, in order to provide free riding. Therefore, the examiner

Art Unit: 2623

submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson media accordingly for the above stated advantages.

As to claim 174-176, please see rejection of claim 155.

As to claim 177, note the Robertson Article that discloses a system for recommending books to users based favorite authors. The claimed “storing data representing characteristics of media previously selected by a respective user” is met by “[t]he customer touches the names of favorite authors, and the program, a sort of ‘smart clerk,’ searches for authors that the customer might also like” wherein it is inherent that the favorite authors (characteristics of media previously selected) be stored, at least temporarily, in the system in order to perform the search for authors that the customer might also like. The claimed “wherein the data representing characteristics of media previously selected by the respective user are not input by that user” is met by the entry of favorite authors by touching the name, as discussed above, wherein favorite authors is a preexisting condition/characteristics which is not input by the user (paragraph 12). The claimed “determining a set of available media [...], the set being associated with data representing characteristics of members of the set of available media [...]" and “determining a correspondence between data representing a member of the set of available media [...] and data representing characteristics of media previously selected by the user” are met by “the program, a sort of ‘smart clerk,’ searches for authors that the customer might also like” in accordance with the store’s inventory (available media) (paragraph 12) wherein the search represents said characteristics of media previously selected by said user in that a person forms opinions as to favorite authors from opinions of books (media) by various authors that had been previously selected/read. The claimed “outputting, for the user, an identification of at least one member of

Art Unit: 2623

the set of available media having characteristics corresponding to characteristics of previously selected media by that user” is met by the recommendation of books to the passerby (paragraph 12) wherein it is inherent that the recommendations be outputted to the user, in order for the system to recommend books to the passerby. Note the Robertson Article teaches media comprising books sold in bookstores. However, the Robertson Article is silent as to “wherein said media comprises a media program.” Now note the WP Article that discloses the sale of audio books in book stores (WP Article, see paragraphs 3 and 19). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson book recommendation system to include the recommendation of audio books (media programs), as taught by the WP Article, for the purpose increasing product sales by making the content of books available to people who otherwise would not have time to read any of the book and to provide a product that “is a marvelous way to supplement [people’s] reading” (WP Article, see paragraph 3).

As to claim 179, note the Robertson Article that discloses a system for recommending books to users based favorite authors. The claimed “storing data representing at least one parameter relating prior selections by a respective user” is met by “[t]he customer touches the names of favorite authors, and the program, a sort of ‘smart clerk,’ searches for authors that the customer might also like” wherein it is inherent that the favorite authors (characteristics of media previously selected) be stored, at least temporarily, in the system in order to perform the search for authors that the customer might also like. The claimed “the at least one parameter not being input by that respective user” is met by the entry of favorite authors by touching the name, as discussed above, wherein favorite authors is a preexisting condition/characteristics which is not

Art Unit: 2623

input by the user (paragraph 12). The claimed “determining a set of available media [...], each member of the set having at least one associated parameter” is met by the store inventory for searching, wherein it is inherent that the media (books) within the store inventory include at least one associated parameter in order for a search for recommendations to be performed (paragraph 12). The claimed “determining a degree of correspondence of prior selections by the respective user and members of the set of available media [...] based on at least the parameters relating to prior selections by the respective user and the associated parameters of members of the set of available media [...]” is met by “the program, a sort of ‘smart clerk,’ searches for authors that the customer might also like” in accordance with the store’s inventory (available media) (paragraph 12) wherein the search represents said characteristics of media previously selected by said user in that a person forms opinions as to favorite authors from opinions of books (media) by various authors that had been previously selected wherein the available media include associated parameters as discussed above. The claimed “outputting a reference to at least one member of the set of available media [...] having an associated parameter based on at least a correspondence to the at least one parameter relating to prior selections by the respective user” is met by the recommendation of books to the passerby (paragraph 12) wherein it is inherent that the recommendations be outputted to the user, in order for the system to recommend books to the passerby. Note the Robertson Article teaches media comprising books sold in bookstores. However, the Robertson Article is silent as to “wherein said media comprises a media program.” Now note the WP Article that discloses the sale of audio books in book stores (WP Article, see paragraphs 3 and 19). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson book

Art Unit: 2623

recommendation system to include the recommendation of audio books (media programs), as taught by the WP Article, for the purpose increasing product sales by making the content of books available to people who otherwise would not have time to read any of the book and to provide a product that “is a marvelous way to supplement [people’s] reading” (WP Article, see paragraph 3).

9. Claims 157, 161, and 163-166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (“New CD-ROM format brings real-time video” of record) in further view of the Washington Post article titled “The Audio Book Business” (“WP Article”) and Hey (US 4,996,462 of record).

As to claim 157, the claimed “wherein said step of notifying said user includes the step of producing a display including a list of the available media meeting a predetermined correspondence criteria on a display screen for viewing by the user.” Note the Robertson Article discloses a system for recommending books to a passerby wherein the system searches for authors that the customer might also like (Paragraph 12). The claimed “available media meeting a predetermined correspondence criteria” is met by “[t]he customer touches the names of favorite authors, and the program, a sort of ‘smart clerk,’ searches for authors that the customer might also like” (Paragraph 12) wherein predetermined correspondence criteria is inherent to the system search for authors that the customer might also like. However, the Robertson Article is silent as to how the recommendations are presented to the customer. Now note the Hey reference that discloses a system and method for recommending items. The claimed “wherein said step of notifying said user includes the step of producing a display including a list of the available media [...] on a display screen for viewing by the user” is met by supplying to display

Art Unit: 2623

22 a list of usually the most highly recommended items for that user (Hey 4:18-22). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson Article book recommendation system with the Hey display for notifying the user of recommendations for the purpose of presenting the recommended items to the customer.

As to claim 161, the claimed “further comprising the step of displaying a list of available programs, and receiving an input for recording a selected one of the available programs.” Note the Robertson Article discloses a system for recommending books to a passerby wherein the system searches for authors that the customer might also like (Paragraph 12). Now note the Hey reference that teaches a system and method for recommending items wherein the items comprise books and movies (Hey 1:37-39); record albums, computer games, television programs, or other consumer items (Hey 7:6-12) wherein a list of recommended items is displayed (Hey 7:33-46). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson media recommendation system for books with the Hey recommendation of items for display including books and television programs for the purpose of providing suggestions for a plurality of different media types including television programs so that a user may quickly identify television programming of interest to a viewer. However, the Robertson and Hey combination is silent as to “receiving an input for recording a selected one of the available programs.” Nevertheless, the examiner takes Official Notice that it is notoriously well known in the art to provide a user a mechanism to record TV programming of interest for the purpose of allowing a user to store programming for viewing at a later time, at the user’s leisure. Therefore, the examiner submits that it would have

Art Unit: 2623

been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson and Hey combination accordingly for the above stated advantages.

As to claim 163, the claimed “wherein said signal controls a recording of a media program.” Note the Robertson Article discloses a system for recommending books to a passerby wherein the system searches for authors that the customer might also like (Paragraph 12). Now note the Hey reference that teaches a system and method for recommending items wherein the items comprise books and movies (Hey 1:37-39); record albums, computer games, television programs, or other consumer items (Hey 7:6-12) wherein a list of recommended items is displayed (Hey 7:33-46). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson media recommendation system for books with the Hey recommendation of items for display including books and television programs for the purpose of providing suggestions for a plurality of different media types including television programs so that a user may quickly identify television programming of interest to a viewer. However, the Robertson and Hey combination is silent as to “wherein said signal controls a recording of a media program.” Nevertheless, the examiner takes Official Notice that it is notoriously well known in the art to provide a user a mechanism to record media of interest for the purpose of allowing a user to store programming for viewing at a later time, at the user’s leisure. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson and Hey combination accordingly for the above stated advantages. Note the signal, as discussed in the rejection of claim 162, controls the a recording of a media in that it provides a listing of media to a user which results in a record request by the user.

Art Unit: 2623

As to claim 164, the claimed “wherein said signal produces a list of choices for a user through a human user interface.” Note the Robertson Article discloses a system for recommending books to a passerby wherein the system searches for authors that the customer might also like (Paragraph 12). However, the Robertson Article is silent as to how the recommendations are presented to the customer. Now note the Hey reference that discloses a system and method for recommending items. The claimed “wherein said signal produces a list of choices for a user through a human user interface” is met by supplying to display 22 a list of usually the most highly recommended items for that user (Hey 4:18-22). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson Article book recommendation system with the Hey display for notifying the user of recommendations for the purpose of presenting the recommended items to the customer.

As to claim 165, the claimed “wherein a user interaction with said system serves as an input to an adaptive algorithm of said processor for determining said correspondence.” Note the Robertson Article teaches searching a store inventory for recommending books and authors to customers. However, Robertson is silent as to an adaptive algorithm. Now note the Hey reference that discloses users of system 10 enter scalar ratings for items they have sampled such as movies (Hey 3:63-66) and the system uses such data to recommend programs (media) to a user (Hey 3:66-4:28) and the algorithm used for the recommendation is adaptive wherein “[i]t is evident that the greater the number of items that the users have sampled, the more accurate the agreement scalar should be for each of the users with which the selected user is paired” (Hey 6:13-16). Therefore, the examiner submits that it would have been obvious to one of ordinary

Art Unit: 2623

skill in the art at the time the invention was made to modify the Robertson recommendation system with the Hey adaptive algorithm for the purpose of increasing the accuracy of recommendations to users and thus increase the possibility of making a sale.

As to claim 166, please see the rejection of claim 165 wherein “[a] still further object of this invention is to provide such a system and method which re[qu]ire little time or effort on the part of each person in a group to obtain accurate recommendations. Another object of this invention is to provide such a system and method which readily assimilate a new person or item and rapidly accomplishes accurate recommendations for each” (Hey 2:37-44).

10. Claims 158-159 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (“New CD-ROM format brings real-time video” of record) in further view of the Washington Post article titled “The Audio Book Business” (“WP Article”), Hey (US 4,996,642 of record), and Bolster (“Reading made fun: BookWhiz” of record).

As to claim 158, the claimed “further comprising a step of altering the produced display by a user using a data entry device.” Note the Robertson and Hey combination teaches the produced display. However, the Robertson and Hey combination is silent as to altering the produced display by a user using a data entry device. Now note the Bolster Article that discloses a list of books wherein “[i]f the book seems interesting and the student wishes to find out more about it, the option ‘S’ will display the remainder of the annotation (up to ten lines), other books by the same author, and books of similar interest” (see page 2). Thus the Bolster Article teaches using a data entry device (keyboard) to alter the produced display by displaying additional information regarding a selected book. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

Art Unit: 2623

Robertson and Hey combination teaching a produced display with the Bolster altering of the produced display for the purpose of presenting a user with additional information about a selected book, such as a summary, so that a user may quickly determine his/her interest in the selected book.

As to claim 159, please see rejection of claim 158 wherein the user may select a book and request additional information.

11. Claims 178 and 180-181 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (“New CD-ROM format brings real-time video” of record) further view of the Washington Post article titled “The Audio Book Business” (“WP Article”) and Bolster (“Reading made fun: BookWhiz” of record).

As to claim 160, the claimed “wherein said data representing said characteristics of media previously selected by said user comprises media theme information.” Note the Robertson and WP combination as discussed in the rejection of claim 155 teaches “wherein said data representing said characteristics of media previously selected by said user comprises [authorship] information.” However, the references do not specifically teach media theme information. Now note the Bolster Article that teaches searching a database to suggest items to a user based on a plurality of characteristics including genre (Bolster, pg.2). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson and WP combination teaching recommending books and audio books based on favorite authors with the Bolster recommendations based on a plurality of characteristics including genre for the purpose of providing a user a more robust method of

Art Unit: 2623

identifying items of interest that will provide a wider variety of suggestions that are more closely tailored to a user's interests.

As to claim 178, the claimed "wherein the identification of at least one member of the set of available media programs having characteristics corresponding to characteristics of previously selected media by that use is presented as a selectable object in a graphic user interface." Note the Robertson and WP articles teach recommending media programs to customers. However, the Robertson is silent as a graphical user interface with a selectable object. Now note the Bolster Article that discloses a list of books wherein "[i]f the book seems interesting and the student wishes to find out more about it, the option 'S' will display the remainder of the annotation (up to ten lines), other books by the same author, and books of similar interest" (see page 2). The Bolster Article further discloses a graphical user interface wherein a menu runs throughout the list "Press S, M, B, P, or Q" wherein "S" corresponds to a see more about this book function. Thus the Bolster Article teaches using a data entry device (keyboard) to select a book (selectable object) from a list including a menu (graphical user interface) to obtain additional information. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson and WP media program recommending system with the Bolster selectable objects within a graphical user interface for the purpose of presenting a user with additional information about a selected book, such as a summary, so that a user may quickly determine his/her interest in the selected book.

As to claims 180 and 181, the claimed "wherein the reference comprises an object in a graphic user interface" and "wherein the reference comprises a selectable object in a graphic user interface." Note the Robertson Article teaches recommending books to customers. However, the

Art Unit: 2623

Robertson is silent as a graphical user interface with a selectable object. Now note the Bolster Article that discloses a list of books (objects) wherein “[i]f the book seems interesting and the student wishes to find out more about it, the option ‘S’ will display the remainder of the annotation (up to ten lines), other books by the same author, and books of similar interest” (see page 2). The Bolster Article further discloses a graphical user interface wherein a menu runs throughout the list “Press S, M, B, P, or Q” wherein “S” corresponds to a see more about this book function. Thus the Bolster Article teaches using a data entry device (keyboard) to select a book (selectable object) from a list including a menu (graphical user interface) to obtain additional information. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson book recommending system with the Bolster selectable objects within a graphical user interface for the purpose of presenting a user with additional information about a selected book, such as a summary, so that a user may quickly determine his/her interest in the selected book.

12. Claims 183, 192, and 193 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachob (US 5,155,591).

As to claim 183, note the Wachob reference that teaches a method and apparatus for providing demographically targeted television commercials. The claimed “receiving data describing a plurality of characteristics of available media” is met by the data describing a plurality of characteristics of available media, commercials (Wachob 6:47-68) wherein it is inherent that the data be received in order for the system to identify the appropriate commercial to target. The claimed “defining data representing a plurality of characteristics of media previously selected by a user” is met by the storage of data including channels/programs viewed

Art Unit: 2623

(Wachob 8:17-33). The claimed “determining a relation between the available media and the media previously selected by the user, based on a respective plurality of characteristics of the available media and media previously selected by the user” is met by the provision of the market research data to advertisers for use in targeting ads to specific television viewers (Wachob 8:17-23; also see entire reference including 4:26-35; 1:25-34). The claimed “producing an output in dependence on the determined relation” is met by the selection and display of the corresponding targeted commercial (Wachob 6:47-68).

As to claim 192, the claimed “further comprising the step of delivering an advertisement to the user in dependence on characteristics of media previously selected by the user” is met by “[i]n the event the cable television system operator wants to provide market research data to advertisers concerning, e.g., demographic information, channels/programs viewed, pay-per-view purchases, etc., RAM 36 will also store cumulative data indicative of the selections made by users via the remote control or converter keyboard” (Wachob 8:17-23) wherein the advertisers uses the market research data to target advertisement to specific television viewers (Wachob, see entire reference including 4:26-35; 1:25-34).

As to claim 193, the claimed “further comprising the step of accounting for delivery of an advertisement to the user” is met by “[m]eans are provided for recording data indicative of commercials transmitted on the cable distribution network from the library, and for billing advertisers based on this data” (Wachob 3:48-51).

13. Claims 185 and 189 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (“New CD-ROM format brings real-time video” of record) in further view of Hey (US 4,996,462 of record of record).

Art Unit: 2623

As to claim 185, the claimed “wherein the available media comprises at least one television program.” Note the Robertson Article discloses a system for recommending books to a passerby wherein the system searches for authors that the customer might also like (Paragraph 12). Now note the Hey reference that teaches a system and method for recommending items wherein the items comprise books and movies (Hey 1:37-39); record albums, computer games, television programs, or other consumer items (Hey 7:6-12) wherein a list of recommended items is displayed (Hey 7:33-46). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson media recommendation system for books with the Hey recommendation of items for display including books and television programs for the purpose of providing suggestions for a plurality of different media types including television programs so that a user may quickly identify television programming of interest to a viewer.

As to claim 189, note the Robertson Article discloses a system for recommending books to a passerby wherein the system searches for authors that the customer might also like (Paragraph 12). Now note the Hey reference that teaches a system and method for recommending items wherein the items comprise books and movies (Hey 1:37-39); record albums, computer games, television programs, or other consumer items (Hey 7:6-12) wherein a list of recommended items is displayed (Hey 7:33-46). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson media recommendation system for books with the Hey recommendation of items for display including books and television programs for the purpose of providing suggestions for a plurality of different media types including television programs so that a user

Art Unit: 2623

may quickly identify television programming of interest to a viewer. However, the Robertson and Hey combination is silent as to “receiving an input for recording a selected one of the available programs.” Nevertheless, the examiner takes Official Notice that it is notoriously well known in the art to provide a user a mechanism to record TV programming of interest for the purpose of allowing a user to store programming for viewing at a later time, at the user’s leisure. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson and Hey combination accordingly for the above stated advantages.

14. Claim 188 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (“New CD-ROM format brings real-time video” of record) further view of Bolster (“Reading made fun: BookWhiz” of record).

As to claim 160, the claimed “wherein said data representing said characteristics of media previously selected by said user comprises media theme information.” Note the Robertson Article as discussed in the rejection of claim 183 teaches “wherein said data representing said characteristics of media previously selected by said user comprises [authorship] information.” However, the references do not specifically teach media theme information. Now note the Bolster Article that teaches searching a database to suggest items to a user based on a plurality of characteristics including genre (Bolster, pg.2). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson Article teaching recommending books based on favorite authors with the Bolster recommendations based on a plurality of characteristics including genre for the purpose

Art Unit: 2623

of providing a user a more robust method of identifying items of interest that will provide a wider variety of suggestions that are more closely tailored to a user's interests.

15. Claim 190 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson ("New CD-ROM format brings real-time video").

As to claim 190, the claimed "further comprising the step of restricting a use of available media in dependence on a financial transaction." Note the Robertson Article teaches selling books at a book store as discussed in the rejection of claim 183. However, the Robertson Article is silent regarding "wherein a presentation of media is restricted in dependence on a financial transaction." Nevertheless, the examiner takes Official Notice that it is notoriously well known in the art of product sales to restrict access to the products until purchased, such as sealing magazines, videos, or books which cannot be opened until the consumer has purchased the product for the purpose of ensuring that the authors of the works/products and seller receive compensation for the consumption of the products, in order to provide free riding. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson media accordingly for the above stated advantages.

As to claim 191, the claimed "further comprising the step of financially accounting in dependence on the output" is met by the rejections of claims 190 and 183 as described above wherein the outputted recommendations results in a purchase of the product/work for consumption thus resulting in a financial accounting that depends on the outputted recommendations.

Art Unit: 2623

16. Claims 168 and 170-173 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson ("New CD-ROM format brings real-time video" of record) in further view of Hey (US 4,996,462 of record) and Wachob (US 5,155,591).

As to claim 168, note the Robertson Article that discloses a system for recommending books to users based favorite authors. The claimed "a user interface for receiving a selection of a media item from a user and for delivering a response to the selection" is met by "[t]he customer touches the names of favorite authors, and the program, a sort of 'smart clerk, searches for authors that the customer might also like" (paragraph 12). The claimed "a processor for searching media items available for selection and for presenting a recommendation of at least one available media item to the user, based on a correspondence of said selection and characteristics of available media items input independently of the user" is met by "the program, a sort of 'smart clerk,' searches for authors that the customer might also like" in accordance with the store's inventory (available media) (paragraph 12) wherein the search represents said characteristics of media previously selected by said user in that a person forms opinions as to favorite authors from opinions of books (media) by various authors that had been previously selected. Further note the Hey reference that teaches a system and method for recommending items wherein the items comprise books and movies (Hey 1:37-39); record albums, computer games, television programs, or other consumer items (Hey 7:6-12) wherein a list of recommended items is displayed (Hey 7:33-46). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson media recommendation system for books with the Hey recommendation of items for display including books and television programs for the purpose of providing

Art Unit: 2623

suggestions for a plurality of different media types including television programs so that a user may quickly identify television programming of interest to a viewer. However, the Robertson and Hey combination is silent as to “an accounting database for recording commercial transaction data relating to selections made by the user.” Now note the Wachob reference that teaches an accounting database for pay-per-view purchases (Wachob 8:17-33). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson and Hey combination with the Wachob accounting database for the purpose of tracking purchases made by users for billing and providing market research data.

As to claim 170, the claimed “wherein said recommendation presented by said processor produces a display including a list of the available media meeting a predetermined correspondence criteria on a display screen for viewing by the user” is met by the display of a list of recommendations as discussed in the rejection of claim 168.

As to claim 172, note the Robertson and Hey combination teaches providing suggestions for a plurality of different media types including television programs so that a user may quickly identify television programming of interest to a viewer. However, the Robertson and Hey combination is silent as to “wherein said processor controls a recording of a said media item.” Nevertheless, the examiner takes Official Notice that it is notoriously well known in the art to provide a user a mechanism to record TV programming of interest for the purpose of allowing a user to store programming for viewing at a later time, at the user’s leisure. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time

Art Unit: 2623

the invention was made to modify the Robertson and Hey combination accordingly for the above stated advantages.

As to claim 173, the claimed “wherein said database stores a history of selections made by a plurality of users” is met by the storing of channels/programs viewed by a plurality of users as taught by Wachob (Wachob 8:17-33).

17. Claim 169 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (“New CD-ROM format brings real-time video” of record) in further view of Hey (US 4,996,462 of record), Strubbe (US 5,223,924 of record), and Wachob (US 5,155,591).

As to claim 169, note the Robertson, Hey, and Wachob combination as discussed in the rejection of claim 168 teaches “wherein said media items comprise television programs.” However, the references do not specifically disclose “and said stored characteristics comprise a channel guide list, and television program-descriptive text accompanies said channel guide list.” Now note the Strubbe reference that teaches a system and method for automatically correlating user preferences with a T.V. program information database. The claimed “and said data describing available media comprises a channel guide list” is met by “[b]y accessing this database, the user can display ‘Future Programs’ as well as ‘Favorite Broadcast Programs’ using a system of advanced menus and displays and an expanded channel ring” (Strubbe 2:42-49). The claimed “and television program-descriptive text accompanies said channel guide list” is met by program “information can comprise title, channel, category, day, time, length, repeat rate etc., as well as summaries, ratings, recommendations and cost for each of the programs featured” (Strubbe 2:9-12) and “[i]n a preferred embodiment, the processor utilizes ‘free text’ search techniques to correlate the TV program information with the viewer’s preferences” (Strubbe

Art Unit: 2623

1:67-2:2) wherein program “information can comprise title, channel, category, day, time, length, repeat rate etc., as well as summaries [context], ratings, recommendations and cost for each of the programs featured” (Strubbe 2:9-12). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson, Hey, and Wachob combination providing recommendations of television programming by searching a database with the Strubbe channel guide list for the purpose of providing a readily available source television program data for searching in addition to provide additional search attributes so that the system may recommend programming that is better tailored to a user’s preferences.

18. Claim 171 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (“New CD-ROM format brings real-time video” of record) in further view of Hey (US 4,996,462 of record), Wachob (US 5,155,591), and Bolster (“Reading made fun: BookWhiz” of record).

As to claim 171, the claimed “wherein said characteristics comprise an identification of a program type.” Note the Robertson and WP combination as discussed in the rejection of claim 155 teaches “wherein said data representing said characteristics of media previously selected by said user comprises [authorship] information.” However, the references do not specifically teach program type information. Now note the Bolster Article that teaches searching a database to suggest items to a user based on a plurality of characteristics including genre (Bolster, pg.2). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson, Hey, and Wachob combination with the Bolster recommendations based on a plurality of characteristics including genre for the

Art Unit: 2623

purpose of providing a user a more robust method of identifying items of interest that will provide a wider variety of suggestions that are more closely tailored to a user's interests.

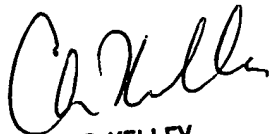
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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